



INTELLECTUAL PROPERTY LAW

Patent, Trademark, Copyright and Internet Law

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Alicia Yoon, CEO
Edward Scott, President
Peach & Lily, Inc.

December 20, 2022

VIA E-MAIL AND FEDEX
To: info@peachandlily.com

2600 Netherland Ave 1520
Bronx, NY 10463

and,

80 W 40th St.
Floor 7
New York, NY 10018

Re: Allegation of Federal Trademark Infringement
and Violation of the Lanham Act
Our Ref. No.: 41948.50014

Ms. Yoon and Mr. Scott,

I represent OY-L Skin Care, LLC (hereinafter “OY-L”). OY-L is the owner of US Trademark Registration 5,429,160 for the mark “BEAUTY WITHOUT SECRETS” in association for the goods of ***“Skin care preparation, namely, body polish; Cosmetic creams for skin care; Fragranced skin care preparations, namely, skin cleansers and skin moisturizers; Non-medicated skin care creams and lotions; Non-medicated skin care preparations; Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels.”*** I have attached a facsimile of this Registration at the end of this letter for your convenient reference.

We recently learned that Peach & Lily, Inc. (hereinafter “Peach”) has made unauthorized use(s) of the trademark “BEAUTY WITHOUT SECRETS” on confusingly similar (actually, identical) goods.

Thus far, we have had three separate entities contact OY-L wrongly believing that Peach’s advertising campaign was OY-L’s. Actual confusion has occurred; there is no need for OY-L to establish the likelihood of confusion.

OY-L demands that Peach immediately cease and desist from all use of the mark “BEAUTY WITHOUT SECRETS.” This letter is also formal notice that Peach’s use of the “BEAUTY

December 20, 2022

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WITHOUT SECRETS” is an infringement of OY-L’s trademark rights under Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a). OY-L believes Peach’s infringement is intentional and deliberate, thereby subjecting Peach’s to treble damages and attorney’s fees under the Lanham Act.

More specifically, the Lanham Act, among others, provides numerous remedies for trademark infringement and dilution, including, but not limited to, preliminary and permanent injunctive relief, money damages, a defendant’s profits, provisions for the destruction or confiscation of infringing products and promotional materials, and where intentional infringement is shown as would be the case here, attorneys’ fees and treble money damages. Judicial relief includes but is not limited to: destruction of the infringing articles under 15 U.S.C. §1118; treble damages, your profits, any damages sustained, court costs and attorney’s fees under 15 U.S.C. §1117; injunction under 15 U.S.C. §1116; injunction and damages under the copyright laws, which FHS is moving the court for said relief.

Based upon the foregoing, OY-L hereby demands that Peach

1. immediately cease and desist and confirm to us in writing by December 31, 2022, that:
 - a. Peach will cease all use of the mark BEAUTY WITHOUT SECRETS by January 16, 2023.
 - b. As much as reasonably possible, by January 16, 2023, Peach will remove product bearing the infringing mark, and remove the physical advertisements currently promoting the infringing use of OY-L’s mark.
 - c. By January 16, 2023, Peach will provide an accounting to OY-L of the sales of products bearing the mark BEAUTY WITHOUT SECRETS and will divulge to OY-L triple the profits flowing from those sales. (If Peach will agree to these terms, no attorney fees will be sought.)

The foregoing is without waiver of all rights of OY-L, all which rights are expressly reserved herein. This correspondence does not constitute an exhaustive statement of OY-L’s position nor is it a waiver of any rights and/or remedies in this and/or any other related business, civil, criminal, or other matter.

EMERSON THOMSON BENNETT




Roger D. Emerson

RDE:rde

December 20, 2022

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BEAUTY WITHOUT SECRETS

Word Mark	BEAUTY WITHOUT SECRETS
Goods and Services	IC 003, US 001 004 006 050 051 052, G & S: Skin care preparation, namely, body polish; Cosmetic creams for skin care; Fragranced skin care preparations, namely, skin cleansers and skin moisturizers; Non-medicated skin care creams and lotions; Non-medicated skin care preparations; Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleansers and peels. FIRST USE: 20160701. FIRST USE IN COMMERCE: 20160701
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	87112709
Filing Date	July 22, 2016
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	November 8, 2016
Registration Number	5429160
Registration Date	March 20, 2019
Owner	(REGISTRANT) OYL Skin Care, LLC LIMITED LIABILITY COMPANY OHIO 526 South Main St., Ste. 615 Akron OHIO 44311
Attorney of Record	Thomas M. Ehrnfeldt
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BEAUTY" APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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Legal Counsel.

DINSMORE & SHOHL LLP
255 East Fifth Street ^ Suite 1900
Cincinnati, OH 45202
www.dinsmore.com

April L. Besl
(513) 977-8527 (direct) ^ (513) 977-8141 (fax)
april.besl@dinsmore.com

December 21, 2022

VIA FEDERAL EXPRESS and
EMAIL: brands@peachandlily.com,
lily@peachandlily.com and
info@peachandlily.com

Alicia Yoon, CEO
Edward Scott, President
Peach and Lily, Inc.
80 W 40th Street
7th Floor
New York, NY 10018

&

2600 Netherland Ave
1520
Bronx, NY 10463

RE: Trademark Infringement of OY-L Skin Care, LLC's Registered Mark

Dear Ms. Yoon and Mr. Scott:

My name is April Besl and I along with my firm are co-counsel to Mr. Roger Emerson of the law firm Emerson Thomson Bennett, LLC for OY-L Skin Care, LLC ("OY-L") on its intellectual property and dispute matters. We write in follow-up to Mr. Emerson's letter, dated December 20, 2022, regarding Peach and Lily, Inc. ("P&L")'s unauthorized use of OY-L's registered and distinctive BEAUTY WITHOUT SECRETS mark.

Since Mr. Emerson's initial correspondence, additional information has come to light regarding the extent of P&L's use which has escalated OY-L's concerns as to the harm to its BEAUTY WITHOUT SECRETS brand. To that end, OY-L has asked us to send this follow-up letter to immediately address the full extent of their concerns.

In short, OY-L has learned that P&L is using its BEAUTY WITHOUT SECRETS mark not only in an online advertising campaign, but also in an extensive advertising campaign throughout the entirety of the New York City subway system, as seen in the attached photograph. It is OY-L understanding that P&L has arranged for its unauthorized use of the BEAUTY WITHOUT SECRETS mark in **every single subway in the City of New York**, visible to over 2.4 million people **every single day**. We further understand that the current P&L subway campaign is set to end at the end of next month. We trust you can understand that this new information, coupled with the existence of actual confusion already arising (as set forth in Mr. Emerson's letter), that OY-L's concerns have been greatly heightened and a more urgent response and action is now required from P&L.

As Mr. Emerson cited, the Lanham Act, 15 U.S.C. § 1114(1)(a), prohibits "any person....without consent of the registrant [from] us[ing] in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive." Moreover, 15 U.S.C. § 1125(a)(1)(A) prohibits "any person...on or in connection with any goods or services, or any container for goods, [from] us[ing] in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin....which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval or his or her goods, services, or commercial activities by another person."

Here, the potential for confusion is extremely high given the identical nature of the marks and the overlapping and competitive¹ goods being offered by the parties. Indeed, as noted previously, not only is confusion likely, **it has already begun**.

In light of the foregoing and the new information uncovered by OY-L, we must amend Mr. Emerson's previous demand and hereby demand that P&L immediately:

1. Immediately and forever cease and desist any and all use of the BEAUTY WITHOUT SECRETS mark or any confusingly similar mark;
2. Immediately arrange for the removal of any and all advertising campaigns, whether online or physical (including but not limited to the subway advertising campaign referenced herein) by **December 31, 2022**; and
3. Provide an accounting of all of P&L's profits made from the use of the BEAUTY WITHOUT SECRETS mark.

¹ As seen in the annexed photograph, taken from a February 2020 Sandbridge Capital press release (available at <https://www.sandbridgecap.com/news/peach-lily-receives-minority-investment-from-sandbridge-capital>, last visited December 21, 2022), P&L sells various skincare products including a skin refining serum, a gel cleanser, an antioxidant cream, moisture pads, toner, and a face mask, the **exact same products** sold by OY-L under its BEAUTY WITHOUT SECRETS mark.

Given the time-sensitive nature of this matter, please provide us with written assurances that you will comply with our request **by the end of this week, December 23, 2022**, explaining the steps taken and any further actions that must be completed.

As a woman owned business, OY-L has no wish to hinder another women owned business, but we trust you can understand that as a trademark owner, OY-L has no choice but to protect its valuable trademark rights from misuse by third parties. OY-L would have welcomed the opportunity for a collaboration with P&L had P&L reached out prior to beginning its use of the BEAUTY WITHOUT SECRETS mark.

To that end, while OY-L is prepared to vigorously defend its rights, it would prefer to resolve this matter amicably and would be willing to explore potential options to resolve this matter quickly. We ask that you or your counsel contact us **before the end of this week** to discuss how this situation can be remedied immediately.

This letter is written without prejudice to OY-L's rights and remedies, including the right to seek an injunction, disgorgement of profits, and attorney's fees, all of which are expressly reserved.

Should you have any questions, please do not hesitate to contact me. We look forward to an expedited and amicable resolution of this matter.

Sincerely,



April L. Besl

Enclosures

cc: Joseph J. Beglane, Esq.

Photograph from New York City Subway



Photograph from Sandbridge Capital Press Release





mwe.com

Jennifer Mikulina
Attorney at Law
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December 23, 2022

VIA EMAIL AND CONFIRMATION BY FEDEX

April L. Besl, Esq.
Dinsmore & Shohl LLP
255 East Fifth Street; Suite 1900
Cincinnati, Ohio 45202
april.besl@dinsmore.com

Re: BEAUTY WITHOUT SECRETS Trademark

Dear Ms. Besl:

We represent Peach & Lily Inc. (“Peach & Lily”) in connection with intellectual property matters. Our client sent us your letter dated December 21, 2022, along with Roger Emerson’s letter from December 20, 2022. We have reviewed both letters and discussed this matter with our client. Although our client respectfully disagrees with the allegations in the letters, Peach & Lily has decided for other business reasons to discontinue the use of the “Beauty Without Secrets” phrase in its advertising campaigns.

Our client appreciates your client’s offer to resolve this matter amicably and agrees to cease all use of the “Beauty Without Secrets” phrase. We understand that our client has already started to transition away from use of the phrase. By the end of this month, Peach & Lily will have removed all references to the “Beauty Without Secrets” phrase from its website. Our client will exclude the phrase from all new social media posts beginning on January 1, 2023. Peach & Lily has also initiated the transition away from use of the phrase on physical materials (including the removal of the phrase from advertising on public transportation). We understand that this process may take more time, but our client expects to have it complete by the end of January 2023.

We trust that this immediate response to your letter and Peach & Lily’s cooperation with your client’s requests has addressed your client’s concerns. Please contact me if you would like to discuss further.

Sincerely,

Jennifer Mikulina

cc: Peach & Lily, Inc.
Raymond A. Jacobsen, Jr. Esq.
Michael Chu, Esq.

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Will & Emery**

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US practice conducted through McDermott Will & Emery LLP.

From: [Mikulina, Jennifer](#)
To: [Beglane, Joseph](#)
Cc: [Besl, April L.](#); [Wells, Kristi](#); [Chu, Michael](#); [Jacobsen, Raymond](#)
Subject: RE: Response to OY-L Demand Letter
Date: Tuesday, December 27, 2022 6:38:24 PM

Dear Joe,

We received your message and confirmed with our client that the article you quoted in your email below is incorrect.

Best regards,
Jennifer

JENNIFER M. MIKULINA (SHE/HER/HERS)

Partner

McDermott Will & Emery LLP 444 West Lake Street, Suite 4000, Chicago, IL 60606-0029

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Biography | **Website** | **vCard** | **Twitter** | **LinkedIn**

Jeanette McGee, Assistant to Jennifer M. Mikulina

Tel +1 312 899 7166 **Email** jmcgee@mwe.com

From: Beglane, Joseph <Joseph.Beglane@DINSMORE.COM>

Sent: Tuesday, December 27, 2022 9:57 AM

To: Mikulina, Jennifer <jmikulina@mwe.com>

Cc: Besl, April L. <april.besl@dinsmore.com>; Wells, Kristi <kristi.wells@dinsmore.com>; Chu, Michael <Mchu@mwe.com>; Jacobsen, Raymond <rayjacobsen@mwe.com>

Subject: RE: Response to OY-L Demand Letter

You don't often get email from joseph.beglane@dinsmore.com. [Learn why this is important](#)

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Hello Jennifer,

Thank you for your response, and I hope you have had a pleasant holiday season. Before further addressing the substance of this dispute, I have a clarifying question about the facts surrounding your client's used of the BEAUTY WITHOUT SECRETS Mark. In your response to my previous email, you said "[o]ur client's use of the accused phrase in connection with its campaign was scheduled to run through the end of 2023, but our client has agreed to stop use of the phrase in connection with the campaign at the end of January 2023."

Based upon a December 13, 2022 Beauty Independent "Brand Report" article, we were under the impression that your client's New York City subway campaign was going to run only through January 2023. Indeed, that article (available at <https://www.beautyindependent.com/peach-lily-first-ever-brand-campaign-nyc-subway-skin-secrets/>) stated:

Images from the campaign will run on New York City subways through next month, and videos will appear on YouTube and Peach & Lily's website starting today. Ads will extend to connected television (CTV), Facebook, Instagram and TikTok as well.

Could you please provide an explanation for the discrepancy between your last email and this article?

Thank you, and we look forward to working with you to amicably resolve these issues.

Best,
Joe

Dinsmôre

Joseph J. Beglane

Associate

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From: Mikulina, Jennifer <jmikulina@mwe.com>

Sent: Friday, December 23, 2022 7:27 PM

To: Beglane, Joseph <Joseph.Beglane@DINSMORE.COM>

Cc: Besl, April L. <april.besl@dinsmore.com>; Wells, Kristi <kristi.wells@dinsmore.com>; Chu, Michael <Mchu@mwe.com>; Jacobsen, Raymond <rayjacobsen@mwe.com>

Subject: RE: Response to OY-L Demand Letter

Dear April and Joe,

This message is to respond to Joe's email this afternoon. First, the statement that "P&L has essentially proposed that it will phase out the subway campaign discussed in our letter essentially at the same time it was originally set to conclude" is inaccurate. Our client's use of the accused phrase in connection with its campaign was scheduled to run through the end of 2023, but our client has agreed to stop use of the phrase in connection with the campaign at the end of January 2023. This has created a significant expense and burden for our client to make these changes.

We will not respond to your conclusory and unconstructive statements regarding any harm to your client's reputation or goodwill, and there is no need for any accounting as you request. Our client has promptly and directly addressed your client's concerns and has been more than reasonable.

If you wish to continue this discussion, we would be happy to schedule a call on Tuesday, after the holiday.

Best regards,
Jennifer

JENNIFER M. MIKULINA (SHE/HER/HERS)

Partner

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Tel +1 312 984 3620 **Mobile** +1 312 636 9847 **Email** jmikulina@mwe.com

Biography | **Website** | **vCard** | **Twitter** | **LinkedIn**

Jeanette McGee, Assistant to Jennifer M. Mikulina

Tel +1 312 899 7166 **Email** jmcgee@mwe.com

From: Beglane, Joseph <Joseph.Beglane@DINSMORE.COM>

Sent: Friday, December 23, 2022 3:09 PM

To: Mikulina, Jennifer <jmikulina@mwe.com>

Cc: Besl, April L. <april.besl@dinsmore.com>; Wells, Kristi <kristi.wells@dinsmore.com>

Subject: Response to OY-L Demand Letter

You don't often get email from joseph.beglane@dinsmore.com. [Learn why this is important](#)

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Dear Ms. Mikulina,

We confirm receipt of your letter dated December 23, 2022. While OY-L is appreciative of P&L's willingness to resolve this matter amicably and cease its infringement of OY-L's senior BEAUTY WITHOUT SECRETS mark, we note that P&L has essentially proposed that it will phase out the subway campaign discussed in our letter essentially at the same time it was originally set to conclude. Such a timeframe is not reasonable or acceptable to OY-L, who has already suffered serious harm to its brand during what is undoubtedly the busiest time of year for both of our clients.

We ask first that you clarify as to the specific steps being taken to remedy the subway campaign **immediately** and the justification for P&L to continue to enjoy the benefit of OY-L's goodwill in its senior mark in one of OY-L's biggest markets (New York City) until the end of next month instead of being remedied immediately and by **December 31, 2022** to ensure the severity of this damage to OY-L's brand will be mitigated.

Additionally, we again ask that you provide an accounting of the amount of sales by P&L throughout the duration of the campaign, both online and physical.

We look forward to hearing from you so we can advise our client accordingly.

Best regards,

Joe

Dinsmore

Joseph J. Beglane

Associate

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